

1 The opinion in support of the decision being entered
2 today is *not* binding precedent of the Board.
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4
5 UNITED STATES PATENT AND TRADEMARK OFFICE
6

7
8 BEFORE THE BOARD OF PATENT APPEALS
9 AND INTERFERENCES
10

11
12 *Ex parte* PRAVEEN SESHADRI, HOLLY KNIGHT,
13 ROBERT H. GERBER, and STEPHEN E. DOSSICK
14

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16 Appeal 2007-0474
17 Application 10/692,885¹
18 Technology Center 2100
19

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21 Decided: September 6, 2007
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25 Before HOWARD B. BLANKENSHIP, ALLEN R. MACDONALD, and
26 JEAN R. HOMERE, *Administrative Patent Judges*.
27

28 MACDONALD, *Administrative Patent Judge*.
29

30 DECISION ON APPEAL
31

¹ Filing date: October 24, 2003. The real party in interest is Microsoft Corporation.

STATEMENT OF THE CASE²

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 1-37 entered October 5, 2005. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants invented a system and method for defining and controlling personalized folders by end-users' specified logic or preferences. End-users can define conditions and actions that control the content of folders upon the happening of an event. (Specification 5:23-25).

The appeal contains claims 1-37. Claims 1, 18 and 30 are independent claims. As best representative of the disclosed and claimed invention, claims 1 and 30 are reproduced below:

1. A system for organizing data, comprising:
a data storage component;
a plurality of folders comprising links to particular data files stored in the data storage component, the content of the folders controlled at least in part by end-user specified preferences, the folders include any type of link collection defined by a set of relationships.

30. A method of personalizing computers functionality, comprising:
writing user preferences with respect to one or more named groups of data in accordance with a developer schema;
executing user preferences in response to an event; and
taking action based on a conditionally valid preference.

² Throughout our opinion, we shall make references to Appellants' Appeal Brief ("Br.") filed on March 6, 2006, and Reply Brief ("Reply Br.") filed on July 19, 2006, and to the Examiner's Answer ("Answer") mailed on May 19, 2006, for the respective details thereof.

REFERENCES

The references relied upon by the Examiner in rejecting the claims on appeal are as follows:

Thuraisingham	US 5,481,700	Jan. 2, 1996
Knutson	US 5,870,746	Feb. 9, 1999
Saxe	US 6,343,376 B1	Jan. 29, 2002
Watters	US 6,490,718 B1	Dec. 3, 2002
Ku	US 6,532,471 B1	Mar. 11, 2003

James Bailey, *An-Event-Condition-Action Language for XML*,
(May 7-11, 2002), available at
<http://www.cs.mu.oz.au/~jbailey/papers/www2002.ps>.

The following rejections are before us for review:

(a) Claims 1, 2, 5-16, 18, 21, and 23-28 are rejected under 35 U.S.C. § 102(e) as being anticipated by Knutson;

(b) Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Knutson in view of Bailey;

(c) Claims 17 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Knutson in view of Ku;

(d) Claims 19, 20, and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Knutson in view of Thuraisingham; and

(e) Claims 30-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Knutson in view of Watters and further in view of Saxe.

Throughout our opinion, we shall make references to Appellants' Appeal Brief ("Br.") filed on March 6, 2006, and Reply Brief ("Reply Br.") filed on July 19, 2006, and to the Examiner's Answer ("Answer") mailed on May 19, 2006, for the respective details thereof.

1 We affirm.³

2 ISSUES

3 Whether Appellants have shown that the Examiner erred in rejecting
4 representative claim 1 based on anticipation, and representative claim 30
5 based on obviousness? The two issues specifically turn on:

6 (A) Whether Knutson expressly or inherently discloses *a plurality of*
7 *folders comprising links to particular data files stored in the data storage*
8 *component, the content of the folders controlled at least in part by end-user*
9 *specified preferences, the folders include any type of link collection defined*
10 *by a set of relationships*, as set forth in Appellants' claim 1.

(B) Whether Appellants have shown that the Examiner erred in rejecting representative claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Knutson, Watters and Saxe. This issue turns on whether it would have been obvious to include *writing user preferences..., executing user preferences..., and taking action based on a conditionally valid preference.*

17

18 FINDINGS OF FACT

19 The following findings of fact (FF) are supported by a preponderance
20 of the evidence.

21 *The Invention*

1. End-users can define conditions and actions that control the content of folders upon the happening of an event. (Specification 5:24-25).

³ Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

1 2. Preferences (e.g., conditions, actions) can,...be boiled down into
2 three categories, preferences that take action on a users' behalf...,
3 preferences that control the content of folders...and a combination of the
4 first two... . (Specification 5:27 to 6:4).

5 3. Appellants state that an end-user writes preferences in accordance
6 with a provided schema. The preferences can be in any form but according
7 to one aspect of the invention they comprise a plurality of IF-THEN
8 statements separated by Boolean operators. The schema can be provided by
9 an application developer to constrain and thereby simplify end-user
10 programming. ...the preference is executed on the occurrence of an
11 event....an action is taken based on a conditionally valid preference.
12 (Specification 113:19-27).

13 4. Appellants disclose that the system can execute a SQL query
14 statement in lieu of the user declaration... (Specification 46:9-11).

15 5. Preferences are specified by an end-user based on a developer
16 schema (e.g., XML schema) and stored in tables in a data store, for example.
17 (Specification 112:2-4).

18
19 *Relating to Anticipation*

20 *Knutson*

21 6. Knutson describes a system and method for "allowing a user to
22 segment and partition a database based upon attributes associated with the
23 data in the database..." (col. 2, ll. 22-25).

24 7. Knutson describes that "[t]he application program allows a user to
25 define predetermined data types, to define relationships between the data
26 types..." (col. 2, ll. 32-34: Abstract).

1 8. Knutson describes “[a]n Alert Condition is a user-defined
2 condition or set of conditions that when satisfied returns an Alert
3 Message..., system 10 produces an Alert Message, InfoFrame...” (col. 3, ll.
4 32-37).

5 9. Knutson discloses that “...InfoFrames are compound documents
6 that display data from a database in text and graphics (e.g., graphs,
7 tables)...InfoFrames may be in the HTML format...” (col. 6, ll. 11-15).

8 10. Knutson discloses that “Client subsystem 12 is a single
9 application program which has a graphical user interface (GUI) 40 and
10 which allows a user to select and specify parameters for InfoFrames, view
11 InfoFrames, print InfoFrames, and save InfoFrames.” (col. 6, ll. 56-59).

12 11. In Knutson, “InfoFrame[s] may include multiple instances of
13 HTML associated with a Measure, representing hyperlinks to text data or
14 graphic data representing the results of the Measure.” (col. 19, ll. 9-11).

15 12. Knutson further discloses a folder management subsystem 54
16 handles all functions relating to manipulating, storing, and retrieving Folder
17 hierarchies, and the InfoFrames and Agents that are stored in those Folders.
18 (col. 8, ll. 38-41).

19 13. In Knutson, a folder stores a list of child folders, a list of
20 InfoFrames, and a list of Agents. Folder objects are created and deleted by
21 folder management subsystem 54 in response to user requests. (col. 8, ll. 51-
22 54).

23 14. Knutson discloses that “[d]isplay area 100 contains a list of
24 folders, which represent the metaphor used by client subsystem 12 in
25 organizing InfoFrames and the analysis that creates them.” (col. 17, ll. 32-
26 34).

1 15. In Knutson, “[s]ubsystems 55B provides a user with the ability to
2 create new measures, update measures, or delete existing measures.” (col. 8,
3 ll. 55-57).

4 16. Knutson discloses that “...[s]ubsystem 55C provides a user with
5 an interface to modify measure relations and to constrain measure relations.
6 ...The relationship between measures and the constraints placed upon them
7 are saved on computer 32 for use in generating InfoFrames.” (col. 8, l. 65 to
8 col. 9, l. 9).

9
10 *Relating to Obviousness*

11 *Knutson*

12 17. Knutson further discloses that “Measure relationships are defined
13 in terms of an if-then statement.” (col. 18, ll. 42-43).

14 18. Knutson looks at the event in the data which must trigger the
15 InfoFrame. (col. 3, ll. 48-53).

16 19. Knutson discloses product categories, e.g., clothing, and looking
17 at attributes of a product. (col. 3, ll. 54-65).

18 20. In Knutson, DAI subsystem 14 provides intelligent middleware
19 for translating graphical user requests, selecting system templates,
20 manipulating data views, and generating dimensional queries for retrieving
21 data from data warehouse 24. ... DAI subsystem 14 also processes updates
22 to this metadata 25 that originate in client subsystem 12 and handles several
23 other kinds of user updates, primarily by passing them to DSM subsystem
24 16. DSM subsystem 16 reads schema from data warehouse 24, creates data
25 views, and creates a mapping between the two. It also uses that mapping to

1 translate the Dimensional Queries received from DAI subsystem 14 into
2 SQL and package and return the results. (col. 6, l. 63 to col. 7, l. 15).

3 21. In Knutson, an Analyst specifies an event in the data which must
4 trigger an Alert; or specifies the type of analysis and the business measures
5 and segments to be reported on in an InfoFrame, and optionally the schedule
6 on which this InfoFrame is to be generated or the event in the data which
7 must trigger the InfoFrame. (col. 3, ll. 48-53).

8
9 PRINCIPLES OF LAW

10 *Relating To Anticipation*

11 “A claim is anticipated only if each and every element as set forth in
12 the claim is found, either expressly or inherently described, in a single prior
13 art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814
14 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Analysis of whether
15 a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a
16 determination of the scope of the claim. We determine the scope of the
17 claims in patent applications not solely on the basis of the claim language,
18 but upon giving claims their broadest reasonable construction in light of the
19 specification as it would be interpreted by one of ordinary skill in the art. *In*
20 *re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827,
21 1830 (Fed. Cir. 2004). The properly interpreted claim must then be
22 compared with the prior art.

23
24 *Relating to Obviousness*

25 “Section 103 forbids issuance of a patent when ‘the differences
26 between the subject matter sought to be patented and the prior art are such

1 that the subject matter as a whole would have been obvious at the time the
2 invention was made to a person having ordinary skill in the art to which said
3 subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727,
4 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is
5 resolved on the basis of underlying factual determinations including (1) the
6 scope and content of the prior art, (2) any differences between the claimed
7 subject matter and the prior art, (3) the level of skill in the art, and (4) where
8 in evidence, so-called secondary considerations. *Graham v. John Deere Co.*,
9 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S. Ct. at
10 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be
11 reordered in any particular case, the [*Graham*] factors continue to define the
12 inquiry that controls.”)

13 In *KSR*, the Supreme Court emphasized “the need for caution in
14 granting a patent based on the combination of elements found in the prior
15 art,” *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which
16 a patent might be determined to be obvious. In particular, the Supreme
17 Court emphasized that “the principles laid down in *Graham* reaffirmed the
18 ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S. Ct. at 1739,
19 82 USPQ2d at 1395 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12
20 (1966) (emphasis added)), and reaffirmed principles based on its precedent
21 that “[t]he combination of familiar elements according to known methods is
22 likely to be obvious when it does no more than yield predictable results.” *Id.*
23 The Court explained:

24 When a work is available in one field of endeavor,
25 design incentives and other market forces can
26 prompt variations of it, either in the same field or a
27 different one. If a person of ordinary skill can
28 implement a predictable variation, §103 likely bars

1 its patentability. For the same reason, if a
2 technique has been used to improve one device,
3 and a person of ordinary skill in the art would
4 recognize that it would improve similar devices in
5 the same way, using the technique is obvious
6 unless its actual application is beyond his or her
7 skill.

8 *Id.* at 1740, 82 USPQ2d at 1396. The operative question in this “functional
9 approach” is thus “whether the improvement is more than the predictable use
10 of prior art elements according to their established functions.” *Id.*

11 A disclosure that anticipates under 35 U.S.C. § 102 also renders the
12 claim unpatentable under 35 U.S.C. § 103, for “anticipation is the epitome of
13 obviousness.” *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025
14 (Fed. Cir. 1984). *See also In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ
15 569, 571 (CCPA 1982); *In re Pearson*, 494 F.2d 1399, 1402, 181 USPQ
16 641, 644 (CCPA 1974).

17 18 ANALYSIS

19 Appellants separately argue claims 1 and 30. For claims 2-29,
20 Appellants merely repeat the same argument made for claim 1. We will
21 therefore treat claims 2-29 as standing or falling with claim 1. For claims
22 31-37, Appellants merely repeat the same argument made for claim 30. We
23 will therefore treat claims 31-37 as standing or falling with claim 30. *See* 37
24 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590,
25 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

26 Appellants have not addressed the level of ordinary skill in the
27 pertinent art of electronic input devices. Accordingly, we will consider
28 Knutson, Bailey, Ku, Thuraingham, Watters, and Saxe as representative of

1 the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d
2 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001) (“[T]he absence of
3 specific findings on the level of skill in the art does not give rise to
4 reversible error ‘where the prior art itself reflects an appropriate level and a
5 need for testimony is not shown’” (internal citation omitted)).

6 Furthermore, Appellants have presented no *secondary considerations*
7 of non-obviousness for our consideration.

8
9 *Anticipation Issue*

10 Issue A: Whether Knutson expressly or inherently discloses *a*
11 *plurality of folders comprising links to particular data files stored in*
12 *the data storage component, the content of the folders controlled at*
13 *least in part by end-user specified preferences, the folders include any*
14 *type of link collection defined by a set of relationships*, as set forth in
15 Appellants’ claim 1.
16

17 Appellants contend that with respect to Knutson, the Examiner has
18 been unable to correlate and provide the necessary interconnection between
19 disparate and unrelated items disclosed in Knutson so as to follow the strict
20 identity requirement required to substantiate a § 102 rejection (Br. 8:7-10).

21 Specifically, Appellants contend that:

22 (1) “...the cited document...,

23 (a) provides a client subsystem having as one of its
24 components a folder management subsystem (rather than a plurality of
25 folders)...” (Br. 5:8-10).

26 (b) “...a message code (instead of a plurality of folders)
27 is linked to both sending and receiving processes...” (Br. 5:10-11).

1 (c) "...a service (rather than links incorporated within
2 particular data files) informs an InfoFrame viewing subsystem that a data
3 file has been updated" (Br. 5: 11-13).

4 Appellants further contend that,

5 (2) "...the Examiner has failed to provide a logical basis upon
6 which to base the assertion that Knutson et al. discloses the entirety of the
7 subject claims." (Br. 6:10-12).

8 (3) "...the Examiner is subscribing to mere probabilities or
9 possibilities in an attempt to found [sic] inherency to substantiate the instant
10 35 U.S.C. §102 rejection." (Br. 6:28-29).

11 (4) "...the Examiner rather than considering the claim as a
12 whole, has dissected the claim into discrete elements and thereupon has
13 conducted an evaluation of the elements in isolation of one another..." (Br.
14 7).

15 After a review of Knutson and considering the arguments presented
16 by Appellants and the Examiner, we find that the system and method for
17 segmenting a database based upon data attributes as disclosed by Knutson
18 anticipates the subject matter of at least representative claim 1.

19 It is axiomatic that anticipation of a claim under § 102 can be found
20 only if the prior art reference discloses every element of the claim. *See In re*
21 *King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and
22 *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730
23 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

24 With respect to claim 1, Appellants argue that the Examiner has
25 presented disparate and unrelated items disclosed in Knutson. While the
26 Examiner's specific cites of Knutson may not be as succinct as Appellants

1 would like to see, upon our review, Knutson as a whole, discloses a system
2 and method that includes a folder management subsystem that manages a
3 plurality of folders (FF 12-14) and stores InfoFrames, e.g., hyperlinks, into
4 such folders (FF 9-11) based on user defined data types and the relationships
5 between the data types (FF 6-7). Thus, Appellants' reliance only upon the
6 Examiner's specific citation of Knutson does not overcome the prima facie
7 case of anticipation whereby a single reference, Knutson, discloses every
8 claimed element, albeit in other portions of the reference that may not have
9 been specifically cited. Anticipation of a claim under § 102 is found if the
10 prior art reference discloses every element of the claim.

11 For example, Appellants define preferences as conditions and/or
12 actions (FF 1-2). Knutson specifically discloses user-defined conditions
13 (FF 8) and the ability of the user to select and specify parameters for
14 InfoFrames (hyperlinks) (FF 10).

15 Thus, it is our view that Knutson discloses a plurality of folders
16 comprising links to particular data files stored in the data storage
17 component, the content of the folders controlled at least in part by end-user
18 specified preferences, and that the folders include any type of link collection
19 defined by a set of relationships, as set forth in claim 1.

20 Therefore, we sustain the Examiner's rejection under 35 U.S.C. § 102.
21

22 *Obviousness Issue*

23 (B) Whether Appellants have shown that the Examiner erred in
24 rejecting representative claim 30 under 35 U.S.C. § 103(a) as being
25 unpatentable over Knutson, Watters and Saxe. This issue turns on
26 whether it would have been obvious to include *writing user*
27 *preferences..., executing user preferences..., and taking action based*
28 *on a conditionally valid preference.*

1 Appellants contend that neither Knutson, Watters nor Saxe,
2 individually and/or in combination, teach or suggest all the novel aspects of
3 Appellants' claimed invention. (Br. 10:1-2). Appellants further contend that
4 the Examiner is relying on contextually disjunctive and logically unrelated
5 passages. (Br. 10:22-26).

6 Upon reviewing the lengthy disclosure of Knutson, it is our view that
7 Knutson indeed discloses user-defined preferences (i.e., condition, actions)
8 (FF 7-10) with respect to one or more named product groups (i.e., groups of
9 data) (FF 19) being defined in terms of if-then statements (FF 17). Knutson
10 further discloses that intelligent middleware translates such preferences by
11 reading schema from the data warehouse and using SQL (FF 20).
12 Furthermore, Knutson discloses that events in the data can be specified and
13 used to trigger an alert (FF 18, 21).

14 In addition, the Examiner found that Watters teaches the use of named
15 groups of data (Answer 14) and that Saxe teaches the use of conditionally
16 valid preferences (Answer 15). Regarding the secondary documents,
17 Appellants merely argue that neither reference makes up for the deficiencies
18 of Knutson (Br. 11). As a result, Appellants fail to address the rationale and
19 merits of the secondary references and, so, does not rebut the prima facie
20 case.

21 In view of the above discussion, it is our view that since Knutson
22 reasonably teaches writing user preferences with respect to one or more
23 named groups of data in accordance with a developer schema and executing
24 user preferences in response to an event, the prior art (Knutson, Watters and
25 Saxe) describe all the elements necessary for a proper rejection under

1 35 U.S.C. § 103 of representative claim 30, as Knutson discloses all that is
2 claimed.⁴

3 Accordingly, we conclude that the subject matter of claim 30 would
4 have been obvious to one of ordinary skill in the art given the teachings of
5 Knutson, Watters, and Saxe.

6 As such, we sustain the Examiner's rejection of claim 30 under 35
7 U.S.C. § 103.

8
9 CONCLUSIONS

10 We conclude that Appellants have not shown that the Examiner erred
11 in rejecting claims 1-37.

12 Thus, claims 1-37 are not patentable.

13
14 DECISION

15 In view of the foregoing discussion, we affirm the Examiner's
16 rejection of claims 1-37.

17 No time period for taking any subsequent action in connection with
18 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

19
20
21 AFFIRMED
22

⁴ The Board may rely on less than all of the references applied by the Examiner in an obviousness rationale without designating it as a new ground of rejection. *In re Bush*, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2 150 USPQ 441, 444 n.2 (CCPA 1966).

Appeal 2007-0474
Application 10/692,885

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